

### **REMARKS**

Of claims 28-39 previously presented, claims 29-30 and 35-36 were withdrawn as drawn to a non-elected species. Applicants appreciate the Examiner's allowance of claims 34 and 38-39, and his indication that claim 37 would be allowable if the rejection under U.S.C. Section 112, second paragraph, is overcome. The remaining claims (i.e., claims 28 and 31-33) stand rejected in view of the cited prior art. With the foregoing amendments and following comments, Applicants respectfully request reconsideration and allowance of all pending claims.

Applicant partially traverses the election requirement. The Office action withdraws claims 29-30 and 35-36 as being drawn to a non-elected species, namely Species B. In the Office action dated May 7, 2003, election was required between Species A shown in Fig. 4 and Species B illustrated in Fig. 8. In response, Applicants elected Species A for prosecution on the merits. Applicants agree that claims 29-30 and 35-36 are directed to the embodiment of Fig. 8. With respect to claims 35-36, however, Applicants believe that claim 34 (from which claims 35-36 depend) is a generic claim that has been allowed. Accordingly, Applicants request consideration and allowance of claims 35-36 at this time. In addition, Applicants note that claim 28 is also generic, and therefore reserves the right to pursue claims 29-30 in this application once claim 28 is allowed. For the record, Applicants note that claims 28, 31-34, and 37-39 are all generic to species A (Fig. 4) and Species B (Fig. 8).

Claims 31 and 37 stand rejected as indefinite under 35 U.S.C. 112, second paragraph. Specifically, the Office action asserts that it is not clear what structure is set forth by "a material suitable for cutting hemostatic material." Applicants traverse this rejection in view of amended claims 31 and 37. Specifically, claims 31 and 37 are amended to recite that the hemostatic material is a hemostatic foam, and the base and flap are formed of a material suitable for cutting the hemostatic foam. Applicants note that defining an element in functional terms, in this case defining the "material" from which the base and flap are formed by stating what that "material" is capable of cutting, is proper and must be evaluated and considered like any other limitation of the claim. *See, MPEP Section 2173.05(g); In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971); *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-

30, 72 USPQ2d 1001, 1006-09 (Fed. Cir. 2004). Accordingly, the rejection under 35 U.S.C. 112, second paragraph, should be withdrawn.

Turning to the rejection on the art, claims 28, 31, and 33 stand rejected under 35 U.S.C. 102(b) as anticipated by Messmer, Jr. (U.S. Patent No. 1,696,442). Applicants traverse this ground of rejection.

Claim 28 is amended herein to incorporate the subject matter of claim 33, which is now canceled. In addition, claim 28 is amended to specify that the guide edge is “linear”, as is clearly understood from the original specification and drawings (particularly Figs. 4-11). Accordingly, claim 28 now recites a cutting device having, among other things, a linear guide edge projecting from the base and adapted to engage the hemostatic material edge surface, the linear guide edge being aligned along a guide plane that intersects the at least two flat side portions. Messmer, Jr. fails to disclose or suggest a cutting device having the linear guide edge as recited by claims 28-32.

In fact, Messmer, Jr. discloses a die for cutting parts of the uppers for boots and shoes. The die includes a plate 1 having pins 11 for locating a blank 10 on the plate 1. An opening 7 is formed in the plate 1 having edges that conform to the outline of the blank 10. Significantly, the pins 11 are cylindrical and the opening 7 is irregularly shaped. Consequently, if the opening 7 is considered to be the claimed “base first opening” and the pins 11 are considered to be the “guide edge,” then it is evident that the pins 11 are not linear as required in claim 28. Furthermore, the irregularly-shaped opening 7 does not appear to have “two flat side portions” as also specified in claim 28.

Because Messmer, Jr. does not disclose each of the elements recited by the claims at issue, it follows that the claims are not anticipated thereby. In addition, Messmer, Jr. fails to disclose or suggest that it would be desirable to provide a cutting device having a linear guide edge aligned along a guide plane that intersects two flat side portions of an opening, and hence a *prima facie* case of obviousness has not been established. See, *In re Sernaker*, 217 USPQ 1 (Fed. Cir. 1983) and *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. 1985).

Claim 32 stands rejected under 35 U.S.C. 103(a) as obvious over Messmer, Jr. For the same reasons presented above, Applicants traverse this rejection.

**CONCLUSION**

It is submitted that the present application is in good and proper form for allowance. A favorable action on the part of the Examiner is respectfully solicited.

If, in the opinion of the Examiner a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

MILLER, MATTHIAS & HULL

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By:

A handwritten signature in black ink, appearing to read "Brent E. Matthias", written over a horizontal line.

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